REMARKS

In view of the following remarks, the Examiner is respectfully requested to withdraw the rejections and allow Claims 1-14, 16, 25-34, 37, and 43-55, the only claims pending and currently under examination in this application.

Claims 1-14, 16, 25-34, 37, and 43-55 have been rejected under 35 U.S.C. § 102 (a) as being anticipated by Genepix.

As stated in MPEP 2131:

> "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

In order for a cited reference to anticipate a claimed invention the reference must be prior art. To constitute prior art under 102 (a) the Genpix reference must have been published before the conception of the instant invention. Applicant submits herewith the Declaration of Herbert Cattell under 37 C.F.R. §1.131, which provides a showing of facts that the inventor conceived of the claimed invention prior to the November 2000 publication date of the Genepix art. In light of this Declaration, Applicant contends that the Genepix art does not qualify and therefore is not available to be used as prior art to the presently claimed invention.

Accordingly, Applicant respectfully request the rejection of Claims 1-14, 16, 25-34, 37, and 43-55 under 35 U.S.C. § 102 (a) as being anticipated by Genepix be withdrawn.

Claims 1-3, 16, 25-27, 37, 43-45, and 53-55 have been rejected under 35 U.S.C. § 103 (a) as being unpatentable over Yang, et al.

As stated in MPEP 2143:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

In order for a cited reference to render a claimed invention obvious the reference must be prior art. To constitute prior art under 103 (a) the Yang, et al. reference must have been published before the conception of the instant invention. Applicant submits herewith the Declaration of Herbert Cattell under 37 C.F.R. §1.131, which provides a showing of facts that the inventor conceived of the claimed invention prior to the November 2000 publication date of the Yang, et al. art. In light of this Declaration, Applicant contends that the Yang, et al. art does not qualify and therefore is not available to be used as prior art to the presently claimed invention.

Accordingly, Applicant respectfully request the rejection of Claims 1-3, 16, 25-27, 37, 43-45, and 53-55 under 35 U.S.C. § 103 (a) as being anticipated by Yang, et al. be withdrawn.

Atty Dkt. No.: 10010011-1
USSN: 09/775,163

CONCLUSION

The Applicant submits that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone Dianne Rees at 650 485 5999. The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078.

Respectfully submitted,
BOZICEVIC, FIELD & FRANCIS LLP

Date: May 26, 2005

By: _____
Bret Field
Registration No. 37,620

AGILENT TECHNOLOGIES, INC.
Legal Department, DL429
Intellectual Property Administration
P.O. Box 7599
Loveland, CO 80537-0599

F:\DOCUMENT\AGIL\197 (10010011-1)\10010011-1 response to office action of 3-7-05.DOC